

REMARKS/ARGUMENTS

Claims 1, 16, 18, 32, and 37-41 are pending in the application. Claims 1, 16, 18, and 32 are amended. Claims 37-41 are added, and Claims 2-3, 14, 33-34, and 36 are cancelled. The amendments to the claims as indicated herein do not add any new matter to this application. Furthermore, amendments made to the claims as indicated herein have been made to exclusively improve readability and clarity of the claims and not for the purpose of overcoming alleged prior art.

I. CLAIM REJECTIONS--35 U.S.C. § 103

Claims 1-3, 14, 16, 18 and 32-36 were rejected under 35 U.S.C. § 103(a) as being allegedly anticipated by Zigmond et al., U.S. Patent No. 6,698,020 (hereinafter “Zigmond”) in view of Balakrishnan et al., U.S. Patent No. 6,473,903 (hereinafter “Balakrishnan”). This rejection is respectfully traversed.

The Combination

The Office Action fails to provide a feasible motivation for combining Zigmond and Balakrishnan. The Office Action alleges that it would be obvious to combine Zigmond with Balakrishnan “to provide users with an interactive advertising system wherein the users have a choice in which ad they wish to view.” However, Zigmond itself describes an embodiment in which “two or more appropriate advertisements are. . . displayed at the appropriate time using a split-screen The viewer then has the option of choosing one of the displayed advertisements that is of greater interest.” (Zigmond Col 16, Line 65 – Col 17, Line 5). Thus, there would be no motivation to combine Zigmond with Balakrishnan in order to give a user the choice of ads the user wishes to view because this combination of Zigmond and Balakrishnan results in the

disclosure of Zigmond only. Balakrishnan adds nothing to the functionality disclosed in Zigmond, and therefore the combination of Zigmond and Balakrishnan is improper.

Claims 1-3, 14, 16, 18 and 32-36

Even if there is motivation to combine Zigmond and Balakrishnan under 35 U.S.C. § 103(a), the combination fails to teach or suggest the features of Claims 1-3, 14, 16, 18 and 32-36.

Claim 1

Claim 1 recites:

A process for enhancing viewership of television, comprising:

receiving, by a digital video recorder (DVR), a program segment containing a beginning portion of a commercial at a beginning of a commercial break;

during playback of the program segment, displaying the beginning portion of the commercial contained in the program segment for a particular length of time;

pausing playing of the program segment, by the DVR, after displaying the beginning portion of the commercial for the particular length of time;
and

in response to a command from a viewer, performing, at the DVR, at least one of:

playing the remainder of the commercial; and
skipping the remainder of the commercial.

At least the above-bolded features of Claim 1 are not taught or suggested by Zigmond and Balakrishnan, even when taken in combination under 35 U.S.C. § 103(a).

The Office Action fails to allege that any of the cited art teaches “displaying the beginning portion of the commercial break in the program segment,” as recited in the version of Claim 1 being addressed by the Office Action. In MPEP 2143.03, it states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. Nevertheless, neither Zigmond nor Balakrishnan teach or suggest “during

playback of the program segment, displaying the beginning portion of the commercial contained in the program segment for a particular length of time,” as recited by the amended Claim 1.

Zigmond fails to teach or suggest the cited feature of Claim 1. It is admitted by the Office Action that Zigmond fails to disclose “receiving, by the DVR, a program segment containing the beginning portion of the commercial break.” However, the Office Action cites Balakrishnan for allegedly teaching “a television distribution system wherein the user receiver will receive a program segment containing a beginning portion of a commercial break (menu to display ad logos).” (See Office Action Page 5, Lines 10-13). In doing so, the Office Action interprets the menu displayed to a viewer “at the time of a commercial break in the main program” described in Balakrishnan (Col 3 Lines 40-55) to be the “beginning portion of a commercial in a commercial break” recited by Claim 1. However, the menu described in Balakrishnan is not the beginning portion of a commercial, as recited by Claim 1, but is a menu sent across the multiplexed data stream separate from the commercials in the data stream. Thus, because Balakrishnan fails to show the “beginning portion of a commercial” recited by Claim 1, Balakrishnan is not sufficient to teach or suggest “receiving, by a digital video recorder (DVR), a program segment containing a beginning portion of a commercial at a beginning of a commercial break; [and] during playback of the program segment, displaying the beginning portion of the commercial contained in the program segment for a particular length of time,” as recited by Claim 1.

The Office Action cites Zigmond Col 15, Lines 45-65; and Col 16, Line 65 – Col 17, Line 9 for allegedly teaching “pausing playing of the program segment, by the DVR, after displaying the teaser.” This is a mischaracterization of the art. Furthermore, Zigmond fails to teach or suggest “pausing playing of the program segment, by the DVR, after displaying the beginning portion of the commercial for the particular length of time,” as recited by the amended Claim 1.

Zigmond Col 15, Lines 45-65 describes a pre-defined time for inserting a selected advertisement into a video programming feed. When the pre-defined time comes, the video feed is interrupted and a selected advertisement is shown in its place. See Col 15 Lines 57-61. This interruption of a video feed does not inherently describe “pausing playing of the program segment,” as recited by Claim 1, because the primary video feed of Zigmond could continue to run while the selected advertisement is being shown in its place. In fact, the description of Zigmond teaches away from pausing the primary video feed while displaying the alternate advertisement. (See Col 3, Lines 7-22 indicating the conventional method of “inserting advertisements” into a video stream does not include pausing the video stream.) Thus, this section of Zigmond fails to teach “pausing playing of the program segment” recited by Claim 1.

Zigmond Col 16, Line 65 – Col 17, Line 9 also fails to teach or suggest the cited features of Claim 1. This portion of Zigmond describes displaying an option of two advertisements to play during a particular time spot, i.e., with a split screen. The user has the option of choosing one of the advertisements to view, and a default commercial is played if the user makes no selection. However, the cited portion of Zigmond makes no mention of pausing the video feed into which the split screen of the two advertisements is inserted. Zigmond does not inherently teach pausing the video feed because it is not necessary to pause the feed in order to accomplish the disclosure of Zigmond. For example, if the time slot for the commercial is one minute long, then Zigmond may display the menu for 30 seconds, after which time a default commercial is chosen to play in the remaining 30 seconds, thus allowing the user an opportunity to choose an advertisement without pausing the video feed.

Furthermore, Zigmond does not describe in any way “pausing playing of the program segment, by the DVR, after displaying the beginning portion of the commercial [contained in the

program segment] for the particular length of time” recited by Claim 1. Thus, Zigmond fails to teach or suggest the cited feature of Claim 1. It is not even alleged that Balakrishnan teaches this feature of Claim 1.

Neither Zigmond nor Balakrishnan teach or describe “in response to a command from a viewer, performing, at the DVR, at least one of: playing the remainder of the commercial; and skipping the remainder of the commercial” recited by Claim 1.

As previously indicated, neither Zigmond nor Balakrishnan teach or suggest “during playback of the program segment, displaying the beginning portion of the commercial contained in the program segment for a particular length of time,” as recited by Claim 1. Thus, because neither of the cited art describe displaying the beginning portion of the commercial, it is illogical that either of the cited art teach or suggest “in response to a command from a viewer, performing, at the DVR, at least one of: playing the remainder of the commercial; and skipping the remainder of the commercial” recited by Claim 1.

Claim 16

Claim 16 recites:

A process for enhancing viewership of television advertisements, comprising:
receiving, by a digital video recorder (DVR), a program segment containing a commercial break;
playing the program segment to a viewer;
detecting, by the DVR, an in-band signal associated with the program segment;
in response to detecting the in-band signal, displaying, by the DVR, a menu as specified by the in-band signal;
pausing playback of the program segment, by the DVR, while displaying the menu; and
wherein the viewer is allowed to either skip past the menu and continue viewing the program segment, thereby causing the DVR to unpause the playback of the program segment, or select a particular item in the menu.

At least the above-bolded features of Claim 16 are not taught or suggested by Zigmond and Balakrishnan, even when taken in combination under 35 U.S.C. § 103(a).

Zigmond and Balakrishnan fail to teach or suggest “detecting, by the DVR, an in-band signal associated with the program segment; [and] in response to detecting the in-band signal, displaying, by the DVR, a menu as specified by the in-band signal” recited by Claim 16.

Balakrishnan does not describe any kind of in-band signal associated with the program segment, as recited by Claim 16. Zigmond describes a triggering signal used to trigger display of commercials inserted into the main video feed. See Col 15 Lines 45-65. This triggering signal is not sufficient to teach or suggest the cited feature of Claim 16 because, in contrast to Zigmond, the response to detection of the signal of Claim 16 is the DVR displaying a menu specified by the in-band signal, and not insertion of a commercial into the video feed. Furthermore, there is no indication that the triggering signal of Zigmond specifies a menu. Thus, Zigmond and Balakrishnan fail to teach or suggest “detecting, by the DVR, an in-band signal associated with the program segment; [and] in response to detecting the in-band signal, displaying, by the DVR, a menu as specified by the in-band signal” recited by Claim 16.

Claim 32

Claim 32 recites:

A process for enhancing viewership of television advertisements, comprising:
receiving, by a digital video recorder (DVR), a program segment containing an introductory portion of a commercial break and a commercial, the introductory portion of the commercial break immediately preceding the commercial in the program segment;
wherein the content of the introductory portion of the commercial break is related to the content of the commercial;
wherein the introductory portion of the commercial break comprises one of: a set of one or more images that introduces the commercial, or a multi-frame video that introduces the commercial;

during playback of the program segment, displaying the introductory portion of the commercial break contained in the program segment for a particular length of time; and
pausing playing of the program segment after displaying the introductory portion of the commercial break.

At least the above-bolded features of Claim 32 are not taught or suggested by Zigmond and Balakrishnan, even when taken in combination under 35 U.S.C. § 103(a). Some of the amendments to Claim 32 were derived from now-cancelled dependent Claim 33, and the references that the Office Action cited with respect to Claim 33 will be addressed with respect to Claim 32.

The Office Action cites Zigmond Col 16 Line 65 – Col 17 Line 9 and Col 9 Lines 9-20 and also Balakrishnan Col 3 Lines 40-56 for allegedly teaching “wherein the teaser is a set of images that indicate a commercial relating to a particular advertisement is present.” However, the cited portions of Zigmond and Balakrishnan fail to teach or suggest “receiving, by a digital video recorder (DVR), a program segment containing an introductory portion of a commercial break and a commercial, the introductory portion of the commercial break immediately preceding the commercial in the program segment; wherein the content of the introductory portion of the commercial break is related to the content of the commercial; [and] wherein the introductory portion of the commercial break comprises . . . a set of one or more images that introduces the commercial,” as recited by the amended Claim 32.

Zigmond Col 16 Line 65 – Col 17 Line 9 describes the display of two advertisements using a split-screen or other arrangement. In citing this portion of Zigmond, the Office Action interprets the display of the two advertisements described in Zigmond to be the introductory portion of a commercial break recited by Claim 32. This is a mischaracterization of the art because the introductory portion of Claim 32 is contained by the program segment. There is no

indication that the split-screen display of the two advertisements of Zigmond is contained in the video programming feed. In fact, Zigmond teaches away from having the two advertisements contained in the video programming feed because, in Col 4 Lines 7-10, Zigmond states that “[t]he present invention is directed to methods and systems for inserting advertisements or other video . . . into video programming.” Thus, Zigmond fails to teach or suggest the “introductory portion of the commercial break,” as recited by Claim 32.

Zigmond Col 9 Lines 9-20 describes “advertisements delivered from ad source 62 are inexpensively converted from traditionally non-video media. For example, text, graphics, pictures, or audio from a computer generated document (i.e., an HTML page) is converted into a video display such as a freeze-frame or slide show.” However, the images described are not contained in a program segment received by a DVR as recited by Claim 32. In fact, Zigmond teaches that these images are received separately from the main video feed and are displayed instead of the main video feed. Furthermore, the images described in this portion of Zigmond do not “introduce[] the commercial,” as recited by Claim 32, but are themselves the commercial. Thus, Zigmond fails to teach or suggest the above-cited features of Claim 32.

Balakrishnan Col 3 Lines 40-56 describes displaying, “at the time of a commercial break,” a menu comprising “several different logos or video sequences . . . [that] are representative or indicative of the different products . . . corresponding to the different commercials which are available for display.” Thus, the Office Action interprets the “menu” of Balakrishnan to be “the introductory portion of the commercial break,” as recited by Claim 32. However, according to Dictionary.com, the Webster’s New Millenium Dictionary defines “commercial break” to be “a pause in a television or radio broadcast for advertisements,” and the Random House Dictionary defines “commercial break” to be “a short interruption during radio or television programming for

the broadcasting of a commercial or commercials.” The introductory portion of the commercial break of Claim 32 is recited as a part of the commercial break. In contrast, because the menu of Balakrishnan is not itself an advertisement or commercial, it cannot be a part of a commercial break. Thus, Balakrishnan fails to teach or suggest “an introductory portion of a commercial break,” as recited by Claim 32.

Zigmond and Balakrishnan also fail to teach or suggest “wherein the introductory portion of the commercial break comprises . . . a multi-frame video that introduces the particular commercial,” as recited by Claim 32, for at least the same reasons as stated above.

Furthermore, Zigmond and Balakrishnan fail to teach or suggest “during playback of the program segment, displaying the introductory portion of the commercial break contained in the program segment for a particular length of time; and pausing playing of the program segment after displaying the introductory portion of the commercial break” recited by Claim 32. This failure stems from the failure to teach or suggest “the introductory portion of the commercial break contained in the program segment” recited by Claim 32, as previously established.

Dependent Claims

Claims 2-3, 14, and 33-36 are cancelled, and therefore the rejection with respect to these claims is moot. Claims 18 and 37-41 each depend from one of the independent claims discussed above. Thus, these dependent claims are patentable over Zigmond and Balakrishnan for at least the same reasons as those discussed in connection with the independent claims upon which they depend. As is discussed above, these independent claims recite features that Zigmond and Balakrishnan do not disclose. Therefore, Claims 18 and 37-41, which inherit these features, are patentable over Zigmond and Balakrishnan, even when considered in combination under 35 U.S.C. §103(a). Reconsideration is respectfully requested.

II. CONCLUSION

Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

The Applicants believe that all issues raised in the Office Action have been addressed and that allowance of the pending claims is appropriate. Entry of the amendments herein and further examination on the merits are respectfully requested.

The Examiner is invited to telephone the undersigned at (408) 414-1214 to discuss any issue that may advance prosecution.

To the extent necessary, Applicants petition for an extension of time under 37 C.F.R. § 1.136. The Commissioner is authorized to charge any fee that may be due in connection with this Reply to our Deposit Account No. 50-1302.

Respectfully submitted,
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